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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,563	11/26/2003	Charles E. Seeney	9701-002	1254

28840 7590 05/02/2006

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EXAMINER

LE, HOA T

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/724,563	Applicant(s) SEENEY ET AL.	
	Examiner H. T. Le	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-71 is/are pending in the application.
- 4a) Of the above claim(s) 15-55 and 67-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. The examiner hereby acknowledges that claims 56-66 were classified under the same group with the elected (now canceled) claims 1-44 during the phone conversation when Applicant's Representative made the election. Thus, the election-restriction portion of the last office action is disregarded, and claims 56-66 are treated as elected claims.

3. Claims 45-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election was made **without** traverse.

Response to Arguments

4. **Claims 60 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite as applied to the rejection to claims 8, 11, 14, 18, and 21 set forth in the last office action.**

It is unclear what is meant by "erodable" polymer. Does it mean decomposable? All organic polymers are decomposable. The specification appears to suggest the term "bio-erodable". Amending "erodable" to "bio-erodable" would obviate this rejection.

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5. Claims 56-66 are rejected under 35 U.S.C. 102(a) being anticipated by pioneers in the art as disclosed by Pankhurst et al. and/or Tartaj et al as applied to the rejection to claims 1-44 set forth in the last office action and further discussed below.

6. Claims 56-66 are rejected under 35 U.S.C. 102(a) as being anticipated by either Wilhelm et al as applied to the rejection to claims 1-4, 14, 23, 24 and 37 set forth in the last office action and further discussed below.

7. Applicant argues that “Pankhurst discusses nanoparticles having a biocompatible shell of silica and a functional group attached to the shell... Pankhurst does not, however, disclose a nanosphere having a plurality of magnetically responsive nanoparticles and a bio-compatible shell prepared by atomization and drying the resulting aerosol in a heated chamber.” With regard to the nanoparticles, the nanoparticles are disclosed as magnetic, thus they are magnetically responsive. The independent claim 56 requires only the presence of magnetically responsive nanoparticles and bio-compatible shell. The coated nanoparticle taught by Pankhurst qualifies as the claimed nanosphere because all elements claimed are met. With regard to the process limitations, claims 56-66 are product claims, thus process limitations are not given any patentable weight. The burden is on applicant to show that the particular process steps as recited in the claims produce a product different from the product taught in the Pankhurst article.

8. Applicant argues that the Tartaj does not teach the claimed invention because Tartaj discloses an aerosol method of producing hollow spheres having a shell formed from small crystallites. It's unclear which article Applicant refers to in the argument because at page

R183, third full paragraph, Tartaj specifically states that “for in vivo applications, the magnetic particles must be coated with a biocompatible polymer during or after the synthesis process to prevent the formation of the large aggregates”. This passage clearly discloses magnetic particles coated with a biocompatible polymer (and the magnetic particles are nanoparticles. The independent claim 56 requires only the presence of magnetically responsive nanoparticles and bio-compatible shell. The coated nanoparticle taught by Tartaj qualifies as the claimed nanosphere because all elements claimed are met. With regard to the process limitations, claims 56-66 are product claims, thus process limitations are not given any patentable weight. The burden is on applicant to show that the particular process steps as recited in the claims produce a product different from the product taught in the Tartaj article.

9. Applicant argues that Wilhelm does not anticipate Applicant’s independent claim 56. Wilhelm teaches a magnetite nanoparticle that is coated with albumin. Albumin is a biological material and thus is biocompatible. The independent claim 56 requires only the presence of magnetically responsive nanoparticles and bio-compatible shell. The coated nanoparticle taught by Wilhelm qualifies as the claimed nanosphere because all elements claimed are met.

10. Applicant's arguments filed December 13, 2005 have been fully considered but they are not persuasive for reasons set forth above.

Conclusion

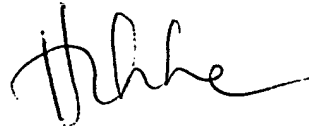
11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'H. T. Le', with a stylized, cursive flourish extending to the right.

H. T. Le
Primary Examiner
Art Unit 1773

April 27, 2006